

REMARKS

Reconsideration of the above-identified patent application is respectfully requested.

Claims 1-20 are currently pending and have been examined on the merits. Claims 1, 3, 5-7, 9, 11 and 16-18 were amended, claim 14 was cancelled and its limitations were incorporated into claim 1. No new matter has been added.

In the Office Action, claims 5, 9, 16 and 18 were objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants amended claims 5, 9, 16 and 18 to place the claims in proper dependent form as requested by the Office Action. In addition, claims 5-7, 9, 14, 16 and 18 were also objected to because of informalities. Claims 5-7, 9, 16 and 18 were amended to correct the informalities as suggested in the Office Action and claim 14 was cancelled rendering its objection moot. Thus, claims 5-7, 9, 16 and 18 are now in proper form and the withdrawal of their objection is respectfully requested.

The Office Action also included the following grounds for rejection:

- (a) Claims 3, 5, 9, and 16-18 were rejected under 35 U.S.C. § 112, ¶ 2, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.
- (b) Claims 1, 5-13, and 15-20 were rejected under 35 U.S.C. § 102(e) as anticipated by Hayashi et al. (U.S. Patent No. 6,699,312, hereinafter “Hayashi”);
- (c) Claims 1, 3-6, 8-10, 12-13, 15-16, 18 and 20 were rejected under 35 U.S.C. § 102(b) as anticipated by Krishnan et al. (U.S. Patent No. 6,444,022, hereinafter “Krishnan (I)”);
- (d) Claims 3-4 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hayashi in view of Asada (U.S. Patent No. 5,800,599, hereinafter “Asada”);

- (e) Claims 7 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krishnan (I);
- (f) Claims 1 and 3-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krishnan et al. (U.S. Patent No. 5,725,646, hereinafter “Krishnan (II)”) in view of Takayama et al. (U.S. Patent No. 6,313,066, hereinafter “Takayama”);
- (g) Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Krishnan (II) in view of Takayama and further in view of Pennaz (U.S. Patent No. 5,338,351, hereinafter “Pennaz”);
- (h) Claims 1, 5-6, 8-10, 12 and 16-20 were rejected 35 U.S.C. § 103(a) as being unpatentable over Incontro et al. (U.S. Patent No. 4,973,617, hereinafter “Incontro”) in view of Navi (U.S. Patent No. 4,445,433, hereinafter “Navi”); and
- (k) Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Incontro in view of Navi and further in view of Pugliese (U.S. Patent No. 3,412,053, hereinafter “Pugliese”).

Applicants respectfully traverse these rejections. For the reasons set forth below, it is believed that the claims are not anticipated or rendered obvious by the cited prior art.

The presently claimed invention is directed to a water-washable lithographic ink composition comprising a rosin-based resin, an alcohol solvent, a pigment an acid neutralizing agent present in an amount of about 5 wt. % to about 15 wt. %, a plasticizer and a latex emulsion (*e.g.*, page 2, lines 25-28 and claim 14 as filed).

A. Rejections Under 35 U.S.C. § 112, ¶ 2

In response to the 35 U.S.C. § 112, ¶ 2 Applicants amended claim 3 to properly state the Markush group. Claims 5, 9, 16 and 18 were amended to recite “the rosin-based resin is present in an amount of more than about 0 wt.” Claim 17 was amended to better define the scope of the

claim to “acrylics,” “methacrylics,” etc. Claims 17 and 18 were also amended to provide proper antecedent basis for their limitations.

Accordingly, the Examiner is kindly requested to withdraw these rejections.

B. Hayashi Does Not Anticipate Applicants' Claims

Hayashi discloses a water/oil emulsion ink for stencil printing which is excellent in storage stability (*e.g.*, col. 2, lines 5-9).

In order to be anticipatory, a reference must describe “each and every element” with the condition that the identical invention must be shown in as complete detail as is contained in the claim. MPEP § 2131.

Hayashi clearly fails to meet the conditions of an anticipatory reference because it fails to teach an ink composition which is water-washable and which comprises an acid neutralizing agent in an amount of about 5 wt. % to about 15 wt. %. In other words, the water/oil emulsion ink composition disclosed in Hayashi is not the presently claimed invention.

On the contrary, in addition to be a water/oil emulsion and no water washable, the ink disclosed in Hayashi does not teach the amount of tertiary amines to add to the composition (*e.g.*, col. 7, lines 27-40).

Accordingly, for the reasons set forth above withdrawal of the rejection of claims 1, 5-13 and 15-20 under 35 U.S.C. § 102(a) is respectfully requested.

C. Krishnan (I) Does Not Anticipate Applicants' Claims

Krishnan (I) teaches a water-based offset ink composition comprising water (*e.g.*, col. 3, lines 39-45). Krishnan (I), as Hayashi above, clearly fails to meet the conditions of an anticipatory reference because it fails to teach the water-washable ink composition of the presently claimed invention which comprises an acid neutralizing agent present in an amount of

about 5 wt. % to about 15 wt. %. On the contrary, the final maximum amount of monoethanolamine disclosed in Krishnan (I) is 2% (e.g., col. 5, line 52).

Accordingly, Krishnan (I) does not anticipate the claimed invention under 35 U.S.C. § 102(b) and reconsideration and withdrawal of the rejection of claims 1, 3-6, 8-10, 12-13, 15-16, 18 and 20 is respectfully requested.

D. Hayashi and Asada Do Not Render Unpatentable Claims 3-4

As set forth above, Hayashi teaches and suggests a water/oil emulsion ink. In other words, Hayashi does not teach and suggests the water-washable ink composition of the presently claimed invention which comprises an acid neutralizing agent in an amount of about 5 wt. % to about 15 wt. %.

Asada also teaches and suggest a water/oil type emulsion ink (e.g., col. 1, lines 33-37). Thus, Hayashi does not render obvious Applicants' claimed invention and Asada fails to make up for Hayashi's deficiency. That is, the combination of Hayashi with Asada does not teach and suggest the water-washable ink composition as claimed. As such, the combination of Hayashi in view of Asada does not render obvious claim 1 from which claims 3 and 4 depend and withdrawal of their rejection under 35 U.S.C. § 103(a) is respectfully requested.

E. Krishnan (I) Does Not Render Unpatentable Claims 7 and 14

The Office policy is to follow *Graham v. John Deere Co.*, in consideration and determination of obviousness under 35 U.S.C. § 103. MPEP 2141(I). However, before answering *Graham*'s content inquiry, it must be known whether a patent or publication is prior art under 35 U.S.C. § 102. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed Circ.), cert. denied, 481 U.S. 1052 (1987).

As set forth above, Krishnan (I) fails to be an anticipatory reference under 35 U.S.C. § 102 because it teaches an ink composition comprising water and 2% monoethanolamine. It

necessary follows that Krishnan (I) fails to be a 35 U.S.C. § 103 reference as well. In other words, because Krishnan (I) does not teach a water-washable ink composition wherein the acid neutralizing agent present in an amount of about 5 wt. % to about 15 wt. %, Krishnan (I) fails to render obvious claim 1 from which claims 7 depend.

Accordingly, claim 14 was cancelled rendering its rejection moot and withdrawal of the obviousness rejection of claim 7 under 35 U.S.C. § 103(a) is respectfully requested.

F. Krishnan (II) And Takayama Do Not Render Unpatentable

Claims 1 and 3-20

As Krishnan (I) above, Krishnan (II) also teaches and suggests a water-based offset ink comprising water and 2% monoethanolamine (*e.g.*, col. 3, lines 17-20, and col. 5, line 15). Takayama teaches and suggests a decolorable image forming material comprising a color former, a developer and a binder (*e.g.*, col. 3, lines 22-27).

Thus, Krishnan (II) does not teach and suggest the water-washable ink composition of the presently claimed invention and Takayama does not make up for its deficiency. In other words, the combination of Krishnan (II) and Takayama is not a water-washable ink with an acid neutralizing agent present in an amount of about 5 wt. % to about 15 wt. %.

Thus, for the reason set forth above, the combination of Krishnan (II) with Takayama do not render unpatentable claims 1 and 3-20 and thus, the withdrawal of their rejection under 35 U.S.C. § 103(a) is respectfully requested.

G. Krishnan (II), Takayama and Pennaz Do Not Render Unpatentable

Claim 2

As set forth above, the combination of Krishnan (II) in view of Takayama does not render unpatentable the presently claimed invention. Pennaz teaches and discloses an oil based or water insoluble lithographic composition used in lithographic printing processes (*e.g.*, col. 5, lines 53-

57). Thus, Pennaz does not make up for the deficiency of the combination of Krishnan (II) with Takayama. In addition, as set forth above, Krishnan (II) teaches and suggests a water-based offset ink comprising 25 to 60 wt. % of water and 2% monoethanolamine. Thus, not only the combination of Krishnan (II) with Takayama and Pennaz is not the water-based composition of the presently claimed invention, but the invention disclosed in Krishnan (II) is not compatible with the oil based or water insoluble composition disclosed in Pennaz. Thus, the teachings of Pennaz cannot even be combined with the teachings of Krishnan (II) and Takayama.

For this reason, Applicants submit that the combination of the cited prior art does not render obvious claim 1 from which claim 2 depends. Thus, the rejection of claim 2 as being unpatentable over Krishnan (II) in view of Takayama and further in view of Pennaz under 35 U.S.C. § 103(a) is respectfully requested.

**H. Incontro And Navi Do Not Render Unpatentable Claims 1, 5-6, 8-10,
12 and 16-20**

Incontro teaches and suggests a water-based ink composition comprising 1% amine for printing onto plastic substrates (*e.g.*, col. 1, lines 33-37, col. 2, line 67, col. 3, line 28, col. 4, line 4 and 18). In other words, Incontro does not teach or disclose a water-washable ink composition with an acid neutralizing agent present in an amount of about 5 wt. % to about 15 wt. %.

Navi teaches and discloses that the anilox roll is used for receiving a precisely metered amount of ink from an ink fountain (*e.g.*, col. 2, lines 34-36). Thus, Incontro does not teach or suggest Applicants' water-washable ink composition as recited in Applicants' amended claims and Navi fails to make up for this deficiency. That is, the combination of Incontro with Navi still does not teach and suggest this aforementioned claim limitation.

Therefore, for the reasons set forth above, Applicants respectfully submit that claims 1, 5-6, 8-10, 12 and 16-20 are patentable and request that their rejection under 35 U.S.C. § 103(a) be withdrawn.

K. Incontro, Navi and Pugliese Do Not Render Unpatentable Claim 13

As set forth above, the combination of Incontro with Navi does not render unpatentable the claimed invention. Pugliese teaches and suggests a quick drying varnish composition comprising a soluble salt of an acidic resin and a soluble salt of an acidic modified drying oil. In other words, the combination of Incontro with Navi does not teach or disclose a water-washable composition with an acid neutralizing agent present in an amount of about 5 wt. % to about 15 wt. % and Pugliese does not make up for this deficiency. That is, the combination of Incontro, Navi and Pugliese still does not teach and suggest this aforementioned claim limitation.

Thus, for the reason set forth above, Applicants respectfully submit that claim 13 is patentable over the combination of the cited prior art and request that such rejection under 35 U.S.C. § 103(a) be withdrawn.

I. Conclusion

In light of the foregoing, all of the pending claims are now believed to be in proper condition for allowance and a Notice to that effect is respectfully requested. If this *Amendment and Response* does not otherwise result in the issue of such Notice, the Examiner is respectfully invited to contact the Applicants' undersigned counsel for an interview.

No extra fee is believed due. However, if any additional fees are necessary, the Director is hereby authorized to charge such fees or credit any overpayment to Deposit Account No. 50-0540.

Respectfully submitted,

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